

UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF NEW YORK

FULL CIRCLE UNITED, LLC, a New York limited liability company;

Plaintiff,  
v.

SKEE BALL, INC., a Pennsylvania corporation,

Defendant.

) Case No.: CV11-5476 (DLI) (LB)  
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**ORAL ARGUMENT REQUESTED**  
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)  
**Documents Filed Herewith:** Notice of  
)  
Motion; Memorandum of Law; Request for  
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Judicial Notice; [Proposed] Order  
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)  
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Honorable Judge Dora L. Irizarry, Presiding  
)  
Magistrate Judge Lois Bloom  
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)  
Complaint filed: November 8, 2011  
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)  
**Date of Service: January 20, 2012**  
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(E-Filing)

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**DECLARATION OF RICHARD J. IDELL IN SUPPORT OF MOTION TO DISMISS  
OR STAY, AND FOR A MORE DEFINITE STATEMENT**

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*Attorneys for Defendant Skee Ball, Inc.,  
a Pennsylvania corporation*

I, Richard J. Idell, do state as follows under the penalty of perjury:

1. I am a partner in the law firm of Idell & Seitel, LLP and am an attorney at law licensed to practice before all of the courts of the State of California. I am an attorney for Defendant SKEE BALL, INC., a Pennsylvania corporation (“SBI”).
2. I make this Declaration pursuant to 28 U.S.C. § 1746.
3. I am familiar with all of the records and files in this action and the underlying facts supporting SBI’s Motion to Dismiss or Stay, and For a More Definite Statement. All of the matters set forth herein are stated of my own personal knowledge or based on my review of the records and files in this action. If sworn as a witness I could and would testify competently to the matters set forth herein.
4. SBI is the owner of the well-known and famous arcade game, Skee Ball (the “Game”), which is over one-hundred years old. In connection with the Game, SBI is and has been – for over eighty years – the sole and exclusive owner, user and licensor of the registered trademark SKEE-BALL® (the “Mark”) for a “game in the nature of a bowling game and parts thereof.” The Mark was originally used in commerce on December 8, 1908. The Mark was registered on the Principal Register of the United States Patent and Trademark Office (“USPTO”) on May 5, 1929, under the Trademark Act of 1905. A true and correct copy of the USPTO Trademark Applications and Registrations Retrieval (“TARR”) database print-out is attached hereto as Exhibit “A” and incorporated herein by this reference; also see Request for Judicial Notice filed herewith (“RJN”).

5. The Mark has been renewed without interruption and remains registered on the Principal Register of the USPTO. SBI owns the registration, which is and continues to be in full force and effect. True and correct copies of the original Mark Registration Certificate issued in

1929, and subsequent renewal Registration Certificates, are attached hereto as Exhibit “B” and incorporated herein by this reference; *also see* RJD.

6. The Mark is incontestable pursuant to 15 U.S.C. § 1065 (Lanham Act § 15) and a Section 15 Affidavit was filed and accepted by the USPTO in or about October of 1954. A true and correct copy of the USPTO Trademark Electronic Search System (“TESS”) database print-out showing the Section §15 Affidavit was filed and accepted is attached hereto as Exhibit “C” and incorporated herein by this reference; *also see* RJD.

7. On February 26, 2008, Full Circle obtained a registration for the trademark BREWSKEE-BALL on the Principal Register of the USPTO, and claimed in its registration application to have been using the mark since December of 2005. *See*, Exhibit “F” to Complaint in the within action.

8. On October 5, 2011, SBI filed suit in the Northern District of California against Full Circle, entitled *Skee Ball, Inc. v. Full Circle United, LLC*, Case No. CV11-4930 EDL (the “SBI Action”). The SBI Action alleges causes of action for: (1) Cancellation of Trademark [15 U.S.C. §§ 1064(3) and 1119]; (2) Trademark Infringement [15 U.S.C. § 1114]; (3) Trademark Dilution and Tarnishment [15 U.S.C. § 1125 (c)]; (4) False Designation of Origin [15 U.S.C. § 1125 (a)]; and (5) Unfair Competition. A true and correct copy of the Complaint in the SBI Action is attached hereto as Exhibit “D” and incorporated herein by this reference.

9. The SBI Action was served on Full Circle on October 19, 2011.

10. On November 8, 2011, one day before Full Circle’s responsive pleading was due in the SBI Action, Full Circle filed the within action (the “Full Circle Action”) based on substantially related and similar facts to those in the SBI Action. A true and correct copy of the Complaint in the Full Circle Action is attached hereto as Exhibit “E” and incorporated herein by

this reference; *also see* RJN.

11. Full Circle was well-aware of the SBI Action when, on November 8, 2011, Full Circle filed the within action based on facts substantially related to those in the SBI Action, but filed in a completely different court. Full Circle knew then and knows now that its claims would be deemed compulsory counterclaims. See email dated January 5, 2012, from counsel for Full Circle stating that “because the cases are not yet consolidated, to preserve our rights we would be filing the allegations of our complaint a second time as counterclaims to [SBI’s] complaint,” attached hereto as Exhibit “F” and incorporated herein by this reference.

12. On November 9, 2011, Full Circle filed a Motion to Dismiss or Transfer the SBI Action to the Eastern District of New York.

13. On December 22, 2011, the SBI Action was ordered transferred to the Eastern District of New York. The SBI Action was transferred and has been assigned to the Honorable Judge Nicholas Garaufis and Magistrate Judge James Orenstein., and assigned Case No. 11-CV-6277 (NGG) (JO). A true and correct copy of the December 22, 2011, Order is attached hereto as Exhibit “G” and incorporated herein by this reference; *also see* RJN.

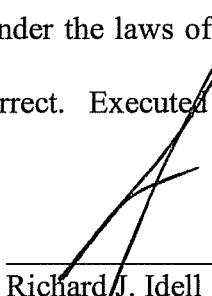
14. On January 3, 2012, SBI, with consent from Full Circle, submitted a letter request to the Court that the SBI Action and the within action be deemed related. A true and correct copy of the January 3, 2012, letter is attached hereto as Exhibit “H” and incorporated herein by this reference; *also see* RJN.

15. On January 9, 2012, Full Circle submitted a letter response to the Court indicating Full Circle’s consent and agreement that the SBI Action and the case at hand are related. A true and correct copy of the January 9, 2012, letter is attached hereto as Exhibit “I” and incorporated herein by this reference; *also see* RJN.

16. On January 17, 2012, Full Circle filed a counterclaim in the SBI Action that is identical to the Complaint except for a venue allegation. A true and correct copy of the Answer and Counterclaim is attached hereto as Exhibit "J" and incorporated herein by this reference; *also see* RJN.

17. On January 19, 2012, local counsel for SBI, Geri Krauss, submitted a letter to the Court advising the Court of SBI's Motion to Dismiss, or alternatively to stay the Complaint in the within action on the grounds that the claims asserted in this action are compulsory counter-claims under F.R.C.P. 13(a), and, if litigated at all, should be litigated in Case No.: 11-CV-6277 (NGG) (JO), where they are now asserted as counter-claims. A true and correct copy of the January 19, 2012, correspondence is attached hereto as Exhibit "K" and incorporated herein by this reference.

I declare under penalty of perjury under the laws of the United States and the State of California that the foregoing is true and correct. Executed this 20th day of January, 2012, at San Francisco, California.



Richard J. Idell